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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,102	01/26/2006	Rico Lampert	022862-1077-00	9574
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EXAMINER				
LUONG, VINH				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,102

Applicant(s)

LAMPERT ET AL.

Examiner

Vinh T. Luong

Art Unit

3656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5 and 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-8 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2010 and 26 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination (RCA) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 21, 2010 has been entered.
2. The restriction requirement and the election of the species of FIGS. 1, 2, and 5 in the parent application are carried over to the instant RCE. Please see MPEP § 819.
3. Claims 3, 5, and 9-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 7, 2009.
4. The drawings were received on September 21, 2010. These drawings are not accepted by the Examiner because the drawings are not in compliance with 37 CFR 1.84 as required under 37 CFR 1.121(d). For example, 37 CFR 1.84(m) states:

The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. *Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object.* Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. *Surface delineations should preferably be shown by proper shading.* Solid black shading areas are not permitted, except when used to represent bar graphs or color. (Emphasis added)

Accordingly, Form PTO-948 attached to the restriction requirement on September 18, 2009 states: "Add some shade lines (FIGS. 1 & 5)." See also ¶ 3 of the Office action on May 27, 2010 and 37 CFR 1.111(b) and (c). However, the amended FIG. 1 and FIG. 5 do not show any shade lines.

5. The drawings are objected to because the drawings are not in compliance with 37 CFR 1.84. Please see Form PTO-948 attached to the restriction requirement on September 18, 2009 and please note that MPEP § 608.02(b) states: "A request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (37 CFR 1.135(c)). Drawing corrections should be made promptly before allowance of the application in order to avoid delays in issuance of the application as a patent or a reduction to any term adjustment. See 37 CFR 1.704(c)(10)." For examples of proper drawings, please see the "Guide for the Preparation of Patent Drawings" available from the USPTO web site at www.uspto.gov.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. *The objection to the drawings will not be held in abeyance.*

6. The claims are objected to because they include reference characters which are not enclosed within parentheses. Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m) and reference character "S" in claims 1 and 17.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 4, 6-8, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenburg et al. (US 4,216,624) in view of Oh et al. (US 7,098,562).

Claims 1 and 17

Blankenburg teaches a gearbox drive unit 1, especially for adjusting movable parts in a motor vehicle, comprising at least one housing part 15 and at least one fixing dome (at 36 or 42 in FIG. 2), which is used to secure the gearbox drive unit 1, characterized in that the housing part 15 comprises a first connection location (at 36) and at least one other second connection location (at 42), whereon the fixing dome (at 36 or 42) is configured to be placed, and that the fixing dome (at 36 or 42) is connected to the housing part 15 at either the first connection location (36) or at the second connection location (42) according to a screw layout (at 42 in FIGS. 2-4, *id.*

3:25-35) for fixation of the gearbox drive unit 1, characterized in that the fixing dome (at 36 or 42) includes a projection 37 (FIG. 6), which engages in a groove 39 in the housing part 15 of the gearbox drive unit 1 in order to create the connection between the fixing dome (at 36 or 42, *id.* 5:59-6:6) and the housing part 15, characterized in that the fixing dome (at 36 or 42) is fixed to a structure, *i.e.*, a motor vehicle body 12 (FIG. 1). (Blankenburg 5:59-6:6)

Blankenburg teaches the invention substantially as claimed. However, Blankenburg does not *explicitly* teach the fixing dome being configured to be displaced along the groove before its fixation on the housing part in order to establish a position that corresponds to the screw layout.

Oh *explicitly* teaches the fixing dome 52 being configured to be displaced (*i.e.*, snap fitted) along the groove (at 56 in FIG. 9) before its fixation on the housing part 34 in order to establish a position that corresponds to the screw layout (unnumbered in FIG. 5). (Oh 3:32-40, claim 6)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to displace the fixing dome of Blankenburg along the groove before its fixation on the housing part in order to establish a position that corresponds to the screw layout as taught or suggested by Oh. The displacement of Blankenburg's fixing dome along the groove (*i.e.*, snap-fitting) as taught or suggested by Oh would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or *the mere application of a known technique* to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739.

Claim 4

Blankenburg teaches: “The two parts of the casing can be firmly connected together by *conventional detachable or permanent connecting elements*, for example by screws or rivets.” (Emphasis added). (Blankenburg 3:25-35)

It is common knowledge in the art to substitute Blankenburg’s connecting elements, such as, screws or rivets by the conventional permanent connecting elements, such as, welding in order to connect Blankenburg’s fixing dome to Blankenburg’s housing part in Blankenburg’s gearbox drive unit modified by Oh. The use of welding as a connecting element is notoriously well known (*e.g.*, see c. 3, ll. 49-57 in US 6,515,399 of Lauf et al. and Description of Prior Art in US 5,045,737 of Yamauchi).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use welding as the connecting element in order to connect Blankenburg’s fixing dome to Blankenburg’s housing part in Blankenburg’s gearbox drive unit modified by Oh as taught or suggested by common knowledge in the art. *KSR supra*.

Claim 6

Blankenburg’s gearbox drive unit 1 includes several fixing domes (at 36 or 42 in FIG. 2) of the same type. Blankenburg’s first and second connection locations are provided on the housing part 15 of the gearbox drive unit 1, whereon the fixing domes (at 36 or 42) are configured to be placed. Blankenburg’s fixing domes (at 36 or 42) are connected to the housing part 15 at selected connection locations (FIG. 2), whereby the selected locations are selected according to the screw layout (at 42) for fixation of the gearbox drive unit 1.

Claim 7

Blankenburg's at least one other fixing dome (at 36 or 42) is provided and that the fixing dome (at 36) and the other fixing dome (at 42) have a common base body 16 so that the fixing dome (at 36) and the other fixing dome (at 42) are configured to be connected jointly to the housing part 15.

Claim 8

Blankenburg's housing part 15 has, at least in sections, a circular ring-shaped section (at 15 in FIGS. 4 and 5), that the common base body 16 of the fixing dome (at 36) and of the other fixing dome (at 42) partially surrounds the circular ring-shaped section (FIG. 2) and are configured to be *operatively* connected at the first and second connection locations (at 36 and 42) with the circular ring-shaped section (FIGS. 2-5).

Claim 18

Blankenburg's dome (at 36 or 42) is arranged such that the dome (at 36 or 42) is capable of sliding by, *e.g.*, unfastening their connecting elements, then, sliding Blankenburg's dome along an edge of the housing part 15 as seen in FIG. 6. In addition, it is well settled that the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997); *In re Danly*, 120 USPQ 528 (CCPA 1959); *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987); and MPEP § 2114.

Claim 20

Blankenburg's at least one housing part 15 includes a fixing element 36 having a first edge (at 37 in FIG. 6) and a second edge (at 38 in FIG. 6) and characterized in that the groove 39 is embodied on *at least one* (at 37 in FIG. 6) of the first edge and the second edge.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blankenburg in view of Oh as applied to claim 1 above, and further in view of Klingler et al. (US 5,836,219).

Blankenburg and Oh teach the invention substantially as claimed. However, Blankenburg and Oh do not teach the at least one housing part including a circular ring-shaped section and characterized in that the groove is embodied circumferentially on the circular ring-shaped section.

Klingler teaches at least one housing part 2 including a circular ring-shaped section (at 2.2 in FIG. 2) and characterized in that the groove 2.2. is embodied circumferentially on the circular ring-shaped section in order to press-fit with the cover 4 of the gearbox drive unit (FIG. 1). (Klingler 3:13-23, claims 1-19)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Blankenburg's at least one housing part including a circular ring-shaped section and characterized in that the groove is embodied circumferentially on the circular ring-shaped section in order to press-fit with the cover/other housing part of Blankenburg's gearbox drive unit modified by Oh as taught or suggested by Klingler. *KSR supra*.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Evans (groove 60 in FIG. 7).

11. Applicant's arguments filed September 21, 2010 have been fully considered but they are not persuasive.

35 USC 112, ¶¶ 1st & 2nd

The previous rejections are withdrawn in view of Applicant's amendments.

35 USC 102(b)

The rejection of claims 1, 6-8, 17, and 18 under 35 USC 102 based on Blankenburg is withdrawn in view of Applicant's amendments to the claims. Applicant's arguments with respect to claims 1, 4, 6-8, and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

CONCLUSION

In view of the foregoing, the Examiner respectfully declines Applicant's request to allow the instant application.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656